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10/076,880	02/13/2002	Yong Wang	13199-B	8827
7590		01/23/2006	EXAMINER	
Frank S. Rosenberg		JOHNSON, EDWARD M		
18 Echo Hill Lane		ART UNIT		
Moraga, CA 94556		PAPER NUMBER		
		1754		
DATE MAILED: 01/23/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

10/076,880

Applicant(s)

WANG ET AL.

Examiner

Edward M. Johnson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,5-26 and 31-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5-23,26 and 31-35 is/are rejected.
- 7) ☒ Claim(s) 24 and 25 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 5-7, 9-15, 19-20, and 33-35 rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wieland et al. 6,413,449.

Regarding claim 1, Wieland '449 discloses a catalyst comprising palladium/zinc and zinc oxide deposited on a metal oxide (see abstract), wherein the catalyst has a hydrogen productivity of more than 20, and up to 60,  $\text{Nm}^3/\text{kg}_{\text{cat}}\cdot\text{h}$  (see column 5, lines 8-15), which would inherently encompass the claimed productivity, since the claimed ingredients and materials are also disclosed. The method of measuring such productivity is not considered to affect the productivity

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itself, which because of the foregoing reasons, is asserted to be an inherent property of the prior art.

When the examiner has reason to believe that the functional language asserted to be critical for establishing novelty in claimed subject matter may in fact be an inherent characteristic of the prior art, the burden of proof is shifted to Applicant to prove that the subject matter shown in the prior art does not possess the characteristics relied upon. In re Fitzgerald et al. 205 USPQ 594.

Regarding claims 5 and 6, Wieland '449 discloses dispersing support and zinc oxide, adding acidic palladium, and adding a base (see column 7, lines 5-13), followed by redispersion and coating with the catalyst material (see column 7, lines 22-24), wherein palladium and zinc that has passed into solution are precipitated together (see column 7, lines 37-40).

Regarding claim 7, Wieland '449 discloses oxide of aluminum, titanium, and zirconium (see abstract).

Regarding claim 9, Wieland '449 discloses palladium and zinc that has passed into solution are precipitated together (see column 7, lines 37-40).

Regarding claim 10, Wieland '449 discloses immersion in a solution of only zinc nitrate (see column 10, lines 58-59).

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Regarding claim 11, Wieland '449 discloses 768.5 g zinc nitrate in one liter of water, which is about 1M zinc.

Regarding claim 12, Wieland '449 discloses dispersing support and zinc oxide, adding acidic palladium, and adding a base (see column 7, lines 5-13), followed by redispersion and coating with the catalyst material (see column 7, lines 22-24).

Regarding claim 13, Wieland '449 discloses neutralizing the acid solution, which would require at least a neutral pH of 7 (see column 7, lines 11-12).

Regarding claim 14, Wieland '449 discloses calcining at 300-550 degrees C (see column 7, lines 25-28).

Regarding claims 15 and 33-35, Wieland '449 discloses depositing Pd as a solution (see Examples) and calcining at 300-550 degrees C (see column 7, lines 25-28), which overlaps Applicant's claimed range with sufficient specificity.

Regarding claims 19-20 and 26, Wieland discloses more than 20, and up to 60,  $\text{Nm}^3/\text{kg}_{\text{cat.h}}$  (see column 5, lines 8-15), which would inherently be characterizable in different units of measurement.

Regarding claim 23 arranging on a surface shell about 250 microns thick (see Example 2).

***Claim Rejections - 35 USC § 103***

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3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this

Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 8, 17-18, 21, 31-32 rejected under 35 U.S.C. 103(a) as being unpatentable over Wieland '449.

Wieland fails to disclose large pores.

It is considered that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use large pores in the support of Wieland because Wieland discloses pore volume impregnation (see Examples) and a specific surface area of 140 square meters per gram (see column 8, line 22), which would obviously, to one of ordinary skill, suggest large pores in order to achieve the discloses surface area.

Regarding claims 17-18 and 21, Wieland discloses 82.6% alumina and 11.6% ZnO.

Wieland fails to disclose 1-15% Pd.

It is considered that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use 1-15% Pd because Wieland discloses 5.8% PdZn alloy, which

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would obviously, to one of ordinary skill, at least suggest an alloy thereof causing between 2% and 5% Pd to be present.

Regarding claim 31, Wieland fails to disclose the Pd depositing subsequent to the drying step.

It is considered that it would have been obvious to one of ordinary skill in the art at the time the invention was made to deposit the Pd after drying because Wieland specifically discloses that it is known to preliminarily coat the support with a pretreatment of zinc followed by drying (see column 3, lines 26-31), which would obviously, to one of ordinary skill, suggest pre-coating with zinc, drying, then depositing Pd.

Regarding claim 32, Wieland '449 discloses calcining at 300-550 degrees C (see column 7, lines 25-28), which overlaps Applicant's claimed range.

5. Claims 16 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wieland '449 as applied to claims 15 and 21 above, and further in view of Feinstein et al. US 4,177,219.

Regarding claims 16 and 22, Wieland fails to disclose Ru.

Feinstein discloses 0.5% Ru (see Table III and claims 3 and 6).

It is considered that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the 0.5% Ru of Feinstein in the reforming catalyst of

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Wieland because Feinstein discloses his 0.5% Ru in a reforming catalyst (abstract, summary) for high scission activity of catalysts (see column 8, lines 20-22) and effective conversion and selectivity (see column 9, lines 35-43).

***Allowable Subject Matter***

6. Claims 24-25 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter: A metal oxide layer of a thickness less than 40 microns and the large pore support is foam or felt in the catalyst of the instant claim 24 would not have been obvious to one of ordinary skill in the art at the time the invention was made. 50% of the catalyst's pore volume being composed of pores in the size range of 0.3 to 200 microns in the catalyst of the instant claims 25 also would not have been obvious to one of ordinary skill in the art at the time the invention was made.

***Response to Arguments***

8. Applicant's arguments filed 11/16/05 have been fully considered but they are not persuasive.



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It is argued that claim 1 recites that "the catalyst... catalyst·hr." This is not persuasive because Applicant's declaration is specific to certain catalysts under certain process conditions, none of which are specified in the claim. Therefore, the information contained in the declaration is not commensurate in scope with the claims.

It is argued that the basis for patentability is simple. This is not persuasive because Applicant has not shown that a claimed product feature results in a higher productivity in a process of using. Rather, all the claimed features specific only to the claimed product itself are disclosed. Applicant merely asserts a higher "productivity", which is also a function of the efficiency of the process of using the catalyst.

It is argued that as stated in MPEP §2173.05(g)... context in which it is used. This is not persuasive because Applicant's cited precedent, *Swinehart*, applies to a property of a product, "transparency to infrared", which can only be present or not in any given product -independent of the process of use-. However, two identical catalysts may result in the same or different "productivity" depending only on whether they are used in the same or different processes. This is not true for "transparency", a product feature which two identical "materials" must necessarily have in common, as in *Swinehart*.

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With respect to *Union Carbide*, also cited by Applicant, the Examiner has indeed "evaluated and considered" the claimed productivity "just like any other limitation of the claim," as set forth therein. The result of the Examiner's evaluation is the conclusion that the claimed productivity is inherent in a catalyst possessing product features of the prior art if used in a process so resulting.

It is argued that in the Official Communication mailed on January 25... meets the claim. This is not persuasive because the claimed productivity is inherent in a catalyst possessing product features of the prior art when used in a process so resulting.

It is argued that in the Official Communication... "... is produced by calcining." This is not persuasive because the final calcining results in the disclosed product of Wieland, which Applicant appears to admit is a catalyst comprising palladium/zinc and zinc oxide "deposited" on a metal oxide (see abstract). Applicant appears to further admit that the disclosed base is added when the Pd is still in "acidic" form, and not after it is already a deposit. The final product, whether produced by calcining or otherwise, occurs after the addition of a base, which is all that is required by the claim.

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Applicant's claimed process does not require that calcining result in a deposit. Rather, so long as the prior art Pd is deposited onto the prior art support after the addition of a base, the claim is met. It is noted that the features upon which applicant relies (i.e., steps requiring that calcining result in a deposit) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

It is argued that "redispersing" the catalyst described at col. 7... suspension of particles. This is not persuasive for the reasons above. The Pd is in "acidic" form and not "deposited" onto the disclosed support until after the disclosed base is added, which is all that is required by the claim. The final product of Wieland does comprise "deposited" Pd (abstract). Therefore, the claim is met whether the "redispersing", "calcining", both, or neither causes the disclosed "deposit" or not, since it happens after the addition of base.

It is argued that the method of claim 5 is further patentable over Wieland... comprising dissolved zinc. This is not persuasive because Applicant appears to admit that Wieland discloses immersing the support in a "dissolved" solution

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containing zinc (see Example 1). Contrary to Applicant's assertion, the disclosure that the support is "immersed" in the solution, is at least as specific as the claimed "adding" of the solution to the support, contrary to Applicant's assertion. Applicant appears to admit that Example 1 discloses a "solution" of zinc nitrate, which anticipates the claimed completely dissolved zinc. Example 1 need not disclose a base, since the addition of base is disclosed elsewhere in the reference, as Applicant appears to also admit.

It is argued that claim 32 recites that the catalyst... exceeding 400 degrees C. This is not persuasive before Wieland is not relied upon for such a disclosure, which is found in Feinstein. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

It is argued that the Feinstein patent is not analogous art. This is not persuasive because it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed

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invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both references are clearly related to the catalyst art and processes of making thereof. Applicant appears to merely point out that the references contain various differences as well, which by itself is not a showing of non-analogous art.

It is argued that there is not a proper motivation to combine the Wieland and Feinstein patents. This is not persuasive because the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is considered that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the 0.5% Ru of Feinstein in the reforming catalyst of Wieland because Feinstein discloses his 0.5% Ru in a reforming catalyst (abstract, summary) for high scission activity of catalysts (see column 8, lines 20-22) and effective conversion and selectivity (see column 9, lines 35-43).

**Conclusion**

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward M. Johnson whose telephone number is 571-272-1352. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley S. Silverman

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can be reached on 571-272-1358. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Edward M. Johnson  
Primary Examiner  
Art Unit 1754

EMJ